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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,496	02/27/2004	Andrew F. Nowak	04236905	7432
26565 7590 03/20/2007 MAYER, BROWN, ROWE & MAW LLP P.O. BOX 2828 CHICAGO, IL 60690-2828			EXAMINER FIDEI, DAVID	
			ART UNIT 3728	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/20/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/788,496

Applicant(s)

NOWAK, ANDREW F.

Examiner

David T. Fidei

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over McLaughlin Jr. (US 2002/0020651). A message delivery device is disclosed by McLaughlin Jr. that provides a unique way of delivering a greeting that is a gift as well, see paragraph [0035]. Hence a gift is disclosed comprising a substantially opaque container 12 and a substantially opaque lid 14 that engages the container wherein the container and lid resemble a pharmaceutical bottle, see paragraph [0023] and paragraph [0024] where a metal container is contemplated; at least one surprise item 20 disposed in the container 12; and written material 13 that accompanies the container, wherein the written material has an interplay with the at least one surprise item in the container. The extent to which the written material provides interplay with the at least one surprise item relates to the specific indicia provided that is not patentably distinct from that printed matter disclosed by McLaughlin because there is no functional relationship between the printed matter and the container per se.

As to claims 2 and 3, the written material is considered as applied both directly to the container and written on a label 13 attached to the container inasmuch as is claimed. To the extent that a label is not considered as resulting in written material applied directly to the container to apply the written material in such a fashion would have been within the level of ordinary skill for the reason of obviating the need for a label.

As to claims 7 and 8 the cap 14 can be either a twist off or a pull off cap type, paragraph [0022] last line. Which is interpreted to mean the cap can have compatible locking structures that are rotated relative to one another or have compatible snap fit structure in the pull off cap type.

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3. Claim 5 rejected under 35 U.S.C. 103(a) as being unpatentable over McLaughlin Jr. (US 2002/0020651) as applied to claim 1 above, and further in view of Crowell (US Patent no.5,836,095). The difference between claim 5 and McLaughlin Jr. resides in the message delivery device being placed within a bag. Crowell discloses a decorative display and article holding system comprising a bag with indicia as shown in figures 9, 10, 13, 14, 23-25. The background of the invention in Crowell states it is known to give gifts in brightly decorated bags with the bag serving as the festive, visually exciting medium for the recipient, col. 1, lines 24-26. It is also stated bags are provided printed indicia such as pictures or designs on the outer surface to provide a visually pleasing appearance, col. 1, lines 39-42 and the bag shown in figures 9, 10, 13, 14, 23-25 has printed indicia on the outside.

It would have been obvious to one of ordinary skill in the art to provide the message delivery container of McLaughlin Jr. placed within a bag with at least some written material on the bag as taught by Crowell in order to provide a visually enhanced appearance in delivering the message delivery device.

Response to Arguments

4. Applicant's arguments with respect to claims 1-3 and 5-8 have been considered but are moot in view of the new ground(s) of rejection. Applicant argues that the prior rejections failed to disclose a "surprise" item because the recipient knows the content of the container. It is submitted such is not the case in the message delivery device of McLaughlin where a personalized message 20 is place within the container. The person receiving the container has no way of ascertaining its contents and McLaughlin even recognizes the device provides a unique way of delivering a greeting or message in a container that is a gift as well as a card, paragraph [0035]. Accordingly, it is submitted there is provided a surprise item inasmuch as is disclosed and claimed by the present invention.


Since the rejection is advanced before Applicant for the first time not necessitated by amendment it is non-final.

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Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fidei whose telephone number is (571) 272-4553. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


David T. Fidei
Primary Examiner
Art Unit 3728

dtf
March 16, 2007